REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 2, 4-7, 9-12, and 14-30 are pending. No new matter has been added.

Rejection of the claims

In the Office Action, independent claims 1, 6, 11, 19, 20, 24, 25, 29 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,769,096 ("Kuppusamy") in view of U.S. Patent No. 6,992,687 ("Baird").

Claim 1 recites:

> 1.   A method performed by a computer system, comprising:
> storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
> at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
> in response to the detected reference, embedding a hyperlink within the detected reference; and
> while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location.

Claim 6 recites:

> 6.   A system, comprising:
> a computing device for:
>> storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
>> at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
>> in response to the detected reference, embedding a hyperlink within the detected reference; and
>> while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location.

Claim 11 recites:

     11.   A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:

> store a version of a paper, the version being displayable on a display device as a likeness of the paper;

> at a first location within the version, detect a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;

> in response to the detected reference, embed a hyperlink within the detected reference; and

> while the first location is displayed on the display device, highlight the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location; and

apparatus from which the computer program is accessible by the computer system.

Claim 19 recites:

     19.   A method performed by a computer system, comprising:

storing a version of a paper, the version being displayable on a display device as a likeness of the paper;

at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;

in response to the detected reference, embedding a hyperlink within the detected reference, wherein the second location is a file external to the paper, and wherein the file includes audio signal information; and

while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user.

Claim 20 recites:

20.   A method performed by a computer system, comprising:
storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
in response to the detected reference, embedding a hyperlink within the detected reference, wherein the second location is a script; and
while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location, wherein the operation includes executing the script in response to a selection of the first location by the user.

Claim 24 recites:

24.   A system, comprising:
a computing device for:
    storing a version of a paper, the version being displayable on a display
        device as a likeness of the paper;
    at a first location within the version, detecting a reference to a second
        location, wherein the detected reference is at least one of the
        following, other than a computer network address: an alphanumeric
        character; a symbol; a term; and a phrase;
    in response to the detected reference, embedding a hyperlink within the
        detected reference, wherein the second location is a file external to
        the paper, and wherein the file includes audio signal information;
        and
    while the first location is displayed on the display device, highlighting the
        first location to indicate the hyperlink as being selectable by a user
        to cause an operation associated with the second location, wherein
        the operation includes outputting audio signals in response to the
        audio signal information and a selection of the first location by the
        user.

Claim 25 recites:

> 25.   A system, comprising:
> a computing device for:
>> storing a version of a paper, the version being displayable on a display device as a likeness of the paper;
>> at a first location within the version, detecting a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
>> in response to the detected reference, embedding a hyperlink within the detected reference, wherein the second location is a script; and
>> while the first location is displayed on the display device, highlighting the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location, wherein the operation includes executing the script in response to a selection of the first location by the user.

Claim 29 recites:

> 29.   A computer program product, comprising:
> a computer program processable by a computer system for causing the computer system to:
>> store a version of a paper, the version being displayable on a display device as a likeness of the paper;
>> at a first location within the version, detect a reference to a second location, wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase;
>> in response to the detected reference, embed a hyperlink within the detected reference, wherein the second location is a file external to the paper, and wherein the file includes audio signal information; and
>> while the first location is displayed on the display device, highlight the first location to indicate the hyperlink as being selectable by a user to cause an operation associated with the second location, wherein the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user; and
> apparatus from which the computer program is accessible by the computer system.

Claim 30 recites:

> 30.   A computer program product, comprising:
> a computer program processable by a computer system for causing the computer system to:
> > store a version of a paper, the version being displayable on a display device as a
> > > likeness of the paper;
> > at a first location within the version, detect a reference to a second location,
> > > wherein the detected reference is at least one of the following, other than a
> > > computer network address: an alphanumeric character; a symbol; a term;
> > > and a phrase;
> > in response to the detected reference, embed a hyperlink within the detected
> > > reference, wherein the second location is a script; and
> > while the first location is displayed on the display device, highlight the first
> > > location to indicate the hyperlink as being selectable by a user to cause an
> > > operation associated with the second location, wherein the operation
> > > includes executing the script in response to a selection of the first location
> > > by the user; and
> apparatus from which the computer program is accessible by the computer system.

MPEP § 2142 states, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

Moreover, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to independent claims 20, 25 and 30, Kuppusamy and Baird are defective in establishing a prima facie conclusion of obviousness. In fact, the Office Action failed to explain the rejections of claims 20, 25 and 30. For example, the Office Action failed to explain how Kuppusamy and Baird combine to teach that: (a) the second location is a script; and (b) the operation includes executing the script in response to a selection of the first location by the user.

Thus, a rejection of claims 20, 25 and 30 is not supported, and Applicant respectfully requests allowance thereof.

In relation to **independent claims 19, 24 and 29**, Kuppusamy and Baird are defective in establishing a prima facie conclusion of obviousness. The Office Action cites Baird's statement (at col. 6, lines 47-49) that, "Other techniques for displaying and manipulating a context menu (e.g., touch screens, voice control and activation, etc.) may also be used." However, such a statement fails to teach the limitation (in claims 19, 24 and 29) that the operation includes outputting audio signals in response to the audio signal information and a selection of the first location by the user. For example, Baird's mention of "voice control and activation" relates to the system's input of audio signals, rather than the system's output of audio signals. Also, Baird's simplistic mention of "etc." is insufficient to establish a prima facie conclusion of obviousness. Thus, a rejection of claims 19, 24 and 29 is not supported, and Applicant respectfully requests allowance thereof.

In relation to **independent claims 1, 6 and 11**, Kuppusamy and Baird are defective in establishing a prima facie conclusion of obviousness. For example, as between Kuppusamy, Baird and Applicant's specification, only Applicant's specification teaches the combinations of elements in claims 1, 6 and 11. In fact, Kuppusamy and Baird teach away from such combinations.

The Office Action acknowledges that Kuppusamy "fails to explicitly state that the embedded hyperlink is found within the detected reference." Nevertheless, the Office Action cites Baird's "selection signal," "page object," and "visual indicator." The Office Action states, "Baird teaches a method of creating a page object in response to a selection signal" (emphasis added). By "page object," the Office Action appears to be citing Baird's "bookmark object."

Claim 1 recites *"embedding a hyperlink within the detected reference,"* yet Baird clearly fails to teach embedding a hyperlink within Baird's selection signal. Consequently, Baird's selection signal *cannot* satisfy the *"detected reference"* in Applicant's claim 1.

Thus, with respect to the *"detected reference"* in Applicant's claim 1, the Office Action appears to be citing Baird's visual indicators 301, 305, 401 and 403, which comprise information (e.g., respective page numbers) that identify parts (of a document) that are marked by the visual indicators 301, 305, 401 and 403.

With respect to the *"embedding a hyperlink within the detected reference"* in Applicant's claim 1, the Office Action appears to be citing Baird's creation of a bookmark object that is linked (e.g., hyperlinked) to a particular part (e.g., page) of a document.

Baird explicitly teaches that its bookmark object is generated "substantially contemporaneously" with rendering its visual indicator. For example, at col. 8, lines 47-48, Baird states, "FIG. 7 is a flow chart illustrating the operation of bookmarks in accordance with the present invention." At col. 8, lines 56-60, Baird states, "In response to the selection signal, at step 702, a visual indicator is rendered on the display that is currently displaying the document being marked. At step 703 and substantially contemporaneously with step 702, a bookmark object is also generated" (emphasis added).

Consequently, Baird's bookmark object (step 703) is *not* generated *in response to* its visual indicator (step 702). Instead, Baird explicitly teaches that both steps 702 and 703 occur "substantially contemporaneously" in response to a user-generated selection signal. For example, at col. 5, lines 8-15, Baird states, "As known in the art, by 'clicking' the mouse while the cursor 211 is pointing to the point 213, a selection signal is generated indicating that the user has selected the point 213. Alternatively, where a touch screen is used, a user need not control a position of a cursor, but may instead simply 'tap' the screen at the selected point 213 in order to generate the selection signal. Regardless of the method used, the selection signal generated in this manner can be used to create a bookmark as described in greater detail below." Further, at col. 9, lines 6-7, Baird states, "As described above, the processing of steps 702 and 703 occurs automatically in response to the selection signal." At col. 9, lines 13-17, Baird states, "In this case, before steps 702 and 703 are carried out, the user is first presented with a choice of which action they would like to perform. Steps 702 and 703 would then be executed after the user has elected to create a bookmark based on his selection signal."

Therefore, Baird explicitly teaches that both steps 702 (visual indicator) and 703 (bookmark object) occur "substantially contemporaneously" in response to a user-generated selection signal. Consequently, Baird's bookmark object (step 703) is *not* generated *in response to* its visual indicator (step 702). Thus, even if the Office Action reads "visual indicator" as being *"detected reference,"* and reads "generating a bookmark object" as being *"embedding a hyperlink within the detected reference,"* Baird would explicitly teach away from Applicant's claim 1,

which recites (in part), *"in response to the detected reference, embedding a hyperlink within the detected reference."*

Clearly, therefore, Baird fails to teach claims 1, 6 and 11, and in fact teaches away from such claims.

Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. In relation to claims 1, 6 and 11, Kuppusamy and Baird are defective in establishing a prima facie conclusion of obviousness. For example, as between Kuppusamy, Baird and Applicant's specification, only Applicant's specification teaches the combinations of elements in claims 1, 6 and 11. In fact, Kuppusamy and Baird teach away from such combinations.

Accordingly, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

Thus, a rejection of claims 1, 6 and 11 is not supported. Likewise, a rejection of claims 19, 20, 24, 25, 29 and 30 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 6, 11, 19, 20, 24, 25, 29 and 30.

Dependent claims 2, 4, 5 and 16-18 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 7, 9, 10 and 21-23 depend from and further limit claim 6 and therefore are allowable.

Dependent claims 12, 14, 15 and 26-28 depend from and further limit claim 11 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 4-7, 9-12, and 14-30 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

Serial No.: 09/690,366   Docket No. 1005.6
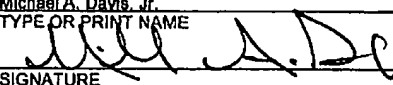Response to Office Action of 01/11/2007   Customer No. 53953

  Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,

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